

REMARKS

Claims 1 and 3-30 are pending in the application. Claims 1, 5, 8, 11, 14, 18, 21, 24, and 27 are independent. Claims 1, 11, and 21 have been amended, and claim 2 has been canceled. It is believed that these changes introduce no new matter and there entry is respectfully requested.

Rejection of Claims 1-3, 11-13, and 21-23 Under 35 U.S.C. §102(b)

In paragraph 5 of the Office Action, the Examiner rejected claims 1-3, 11-13, and 21-23 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,774,859 to Houser et al. (“Houser”). A claim is anticipated only if each and every element of the claim is found, either expressly or inherently, in a reference. (MPEP §2131 *citing Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628 (Fed. Cir. 1987)). The identical invention must be shown in as complete detail as is contained in the claim. *Id. citing Richardson v. Suzuki Motor Co.*, 868 F.2d 1226,1236 (Fed. Cir. 1989)). Applicant respectfully traverses the rejection.

Representative independent claim 1 recites in pertinent part “defining a bounded region on the information display, wherein the information display is at least one of *a three-dimensional display and a holographic display*” (emphasis added). In the Office Action, the Examiner asserts that Houser teaches “a computer-implemented method to select a process from an information display by speaking, comprising: defining a bounded region on the information display; associating at least a part of said bounded region with a color, wherein said color is used to indicate that the process is speech-enabled; and relating a command with at least one of said bounded region, and said color, wherein said command causes the process to be selected when spoken.” Applicants respectfully disagree.

As a first matter, Applicants respectfully submit that Houser is not properly applied to the claimed invention. Houser appears to be directed to a remote control device and electronic programming guide (EPG) for a television and a television subscription service. The problem addressed in Houser is that while a subscriber might be very interested in using an EPG to determine the channel number and time for the next showing of a particular television show or to find all movies being shown in the next week starring a particular actress, such tasks are not easily implemented using conventional menu screens and key presses on a conventional remote control device (col. 2, lines 11-16). The solution proposed by Houser is to add speech

recognition to the television system, which is not necessarily the purview of embodiments of the present invention. Applicant respectfully submits therefore that Houser is not properly applied to the claimed invention.

Even, assuming for the sake of argument, that Houser is properly applied to the claimed invention, as a second matter Applicants respectfully submit that Houser fails to show the identical invention as that of the claimed invention. For example, Houser fails to teach that the information display is at least one of *a three-dimensional display* and *a holographic display* as recited in claim 1, 11, and 21. Because Houser is not properly applied to and/or fails to teach each and every element of the claimed invention, Applicant therefore respectfully submits that claims 1, 11, and 21 are patentable over Houser. Claims 2-3, 12-13, and 22-23 properly depend from patentable claims, and as a result are patentable over Houser as well. Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claims 1-3, 11-13, and 21-23.

Rejection of Claim 4 Under 35 U.S.C. §103(a)

In paragraph 9 of the Office Action, the Examiner rejected claim 4 under 35 U.S.C. §103(a) as being unpatentable over Houser and Official Notice. Applicants respectfully traverse the rejection. Applicants respectfully submit that claim 4 properly depends from patentable claim 1 and thus is patentable for at least the same reasons as claim 1 is patentable. Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claim 4.

Rejection of Claims 5-10, 14-20, and 24-30 Under 35 U.S.C. §103(a)

In paragraph 10 of the Office Action, the Examiner rejected claims 5-10, 14-20, and 24-30 under 35 U.S.C. §103(a) as being unpatentable Houser as applied to claims 1, 11, and 21, and in further view of over U.S. Patent No. 6,085,159 to Ortega et al. (hereinafter “Ortega”). To establish a *prima facie* case of obviousness, an Examiner must show three things: (1) that there is some suggestion or motivation to modify a reference or combine reference teachings to arrive at the claimed invention, (2) that there must be a reasonable expectation of success, and (3) that the references teach or suggest each and every element of the claimed invention. MPEP §2143. In making a determination that there is some suggestion or motivation to modify a reference or combine reference teachings to arrive at the claimed invention the Examiner cannot propose a

modification that would make a reference unsatisfactory for its intended purpose or change its principle of operation. MPEP §2143.01. References cannot be combined where references teach away from their combination. MPEP §2145X.D.2. Applicants respectfully traverse the rejection.

No Motivation or Suggestion to Combine Houser and Ortega

Representative independent claim 5 recites in pertinent part “associating *a second region* of the information display with said bounded region” (emphasis added). In the Office Action, the Examiner concedes that Houser fails to teach associating a second region of the information display with said bounded region, but states that Ortega teaches associating a second region of the information display with said bounded region, citing col. 3, lines 23-27. Applicants respectfully disagree and respectfully submit that combining Houser with Ortega violates the prohibition in MPEP §2145X.D.2 of references being combined when at least one of the references teaches away from their combination.

Ortega appears to be directed to a speech application that displays voice commands with multiple variables. The problem addressed in Ortega is that listing all of the voice commands that a user can say in a window clutters the window. The solution proposed in Ortega is instead of listing each and every possible version of each command, the screen displays a high-level command along with the number of variables for the command is displayed between delimiters after the command. In this way, if there are twenty variables for a command, a user does not see all twenty variables, but merely the fact that twenty variables exist.

As discussed above, Houser appears to be directed to using speech to control a television, such as to increase volume, change a channel, look at the electronic programming guide (EPG), etc. Houser accomplishes this by displaying all of the speech-enabled commands that may be used to control the television.

Applicants respectfully submit that it would not be obvious to combine Houser with Ortega. For example, Ortega is attempting to *reduce the number* of voice commands displayed. Ortega is not interested in displaying all speech-enabled commands. In contrast, Houser *displays the entire vocabulary* available to the subscriber. Combining Houser with Ortega would thus violate MPEP §2145X.D.2 because they teach away from each other. Combining Houser with

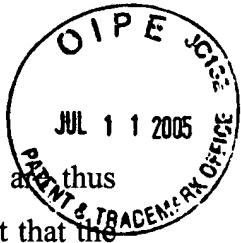
Ortega also would violate MPEP §2143.01 because such a combination would make either Houser or Ortega unsatisfactory for their intended purposes, one of which is to reduce the number of voice commands displayed and the other of which is to display all speech-enabled television controls. Ortega stresses at column 1, lines 14-15 that “listing all these voice commands in a window would clutter the window.”

Failure to Teach Each and Every Element

Representative independent claim 5 recites in pertinent part “*relating a graphical command with* at least one of said bounded region, *said second region*, and said color, wherein said graphical command causes the process to be selected when spoken” (emphasis added). Representative independent claim 24 recites in pertinent part “*a graphical command associated with* at least one of said bounded region, *said second region*, and said color, causes the process to be selected by speaking said graphical command” (emphasis added). Applicants respectfully submit that even if it were proper to combine Houser and Ortega, such a combination fails to teach each and every element of the claimed invention. For example, the combination of Houser and Ortega fail to teach “relating a graphical command with at least one of said bounded region, said second region, and said color, wherein said graphical command causes the process to be selected when spoken” as recited in claims 5, 8, 14, and 18. The combination of Houser and Ortega also fail to teach “relating a graphical command with at least one of said bounded region, said second region, and said color, wherein said graphical command causes the process to be selected when spoken” as recited in claims 24, and 27.

Each Element of the *Prima Facie* Case of Obviousness Not Met

Applicants respectfully submit the Examiner has failed to satisfy each criterion of the *prima facie* case of obviousness with respect to the claimed invention. Applicants only need demonstrate that the Examiner has not met the initial burden of making a *prima facie* case of obviousness with respect to the claimed invention. If the Examiner fails to show that Houser in view of Ortega teaches each and every element of claims 5, 8, 14, 18, 24, and 27 or if the Examiner has improperly combined references, then the Examiner has failed to meet the burden of establishing a *prima facie* case of obviousness of claims 5, 8, 14, 18, 24, and 27 over Houser in view of Ortega. Applicants respectfully submit that they have shown that the Examiner has failed to meet the burden of establishing a *prima facie* case of obviousness of claims 5, 8, 14, 18,



24, and 27 over Houser in view of Ortega and that claims 5, 8, 14, 18, 24, and 27 are thus patentable over Houser in view of Ortega. Accordingly, Applicants respectfully request that the Examiner reconsider and remove the rejection of claims 5, 8, 14, 18, 24, and 27 and their equally patentable dependent claims 6-8, 9-1015-17, 19-20, 25-26, and 28-30.

CONCLUSION

Applicants submit that all grounds for rejection have been properly traversed, accommodated, or rendered moot, and that the application is now in condition for allowance. The Examiner is invited to telephone the undersigned representative if the Examiner believes that an interview might be useful for any reason.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

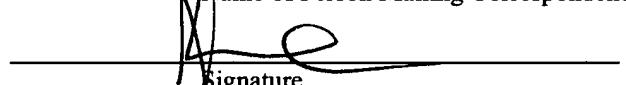
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